

Serial No.: 09/938,155
Art Unit: 2655

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed August 24, 2005. Through this response, claims 7, 8, 10, and 14 have been amended. Reconsideration and allowance of the application and pending claims 1-14 are respectfully requested.

I. Allowable Subject Matter

Applicants appreciate the Examiner's indication that claim 6 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

In that it is believed that every rejection has been overcome, it is respectfully submitted that each of the claims that remains in the case is presently in condition for allowance.

II. Abstract Amendment

The abstract of the disclosure has been amended to include the word "system" before "method" as requested by the Examiner.

III. Specification Amendments

The Examiner has requested the inclusion of various patent numbers corresponding to various serial numbers provided in the specification. Specifically, the Office Action identifies that in the specification, page 1, line 17, after "09/045,134" please add --U.S. 6,025,972--, and in page 13, line 2, after "09/045,558" add --U.S. 6,160,786--.

Applicants have amended the specification to include the two patent numbers as requested by the Examiner. Although these amendments effect various changes to the specification, it is respectfully asserted that no new matter has been added.

Serial No.: 09/938,155
Art Unit: 2655**IV. Claim Rejections - 35 U.S.C. § 102(e)****A. Statement of the Rejection**

Claims 1, 7, 8, 10, 11, and 14 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by *Thayer et al.* ("Thayer," U.S. Pat. No. 6,643,226). Applicants respectfully traverse this rejection.

B. Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the *Thayer* reference.

Independent Claim 1

Claim 1 recites (with emphasis added):

1. A system for providing automated access to a plurality of data media in a data storage system, the system comprising:
 - a drawer configured to receive the plurality of data media;
 - a mounting system attached to the drawer and adapted to be located within an opening in the data storage system and configured to extend and retract the drawer relative to the opening in the data storage system;
 - a drive system operationally attached to the mounting system and configured to position the drawer relative to the opening in the data storage system;* and
 - a control system in communication with the drive system and adapted to control the operation of the drive system, the control system configured to receive information associated with a specific position relative to the opening in the data storage system to which the drawer is to be moved and to operate the drive system to position the drawer in the specific position.

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Applicants respectfully submit that *Thayer* does not disclose at least the emphasized claim features. The Office Action alleges the following on page 4:

The drive system is attached to the mounting system and configured to positions of the drawer relative to the opening in the data storage system (Col. 9, lines 14+).

Applicants respectfully disagree. Column 9, lines 26-30 of *Thayer* provides an example of a mechanism used in the extension and retraction of the drawer in *Thayer* (emphasis added):

In one preferred embodiment, the drawer 16 is slidably mounted to the data storage system 12 by a pair of drawer slides 72, 74 which may be mounted to the frame 76 of drawer 16 and to the chassis 84 of the data storage system 12.

It is not clear from the Office Action what is being equated with a “drive system” or a “mounting system.” Independent claim 1 requires a “mounting system attached to the drawer.” It may also be said that the drawer in *Thayer* is “attached” to the drawer slides through the frame 76 as emphasized above, and in that sense, perhaps the Office Action is equating drawer slides 72 and 74 to a “mounting system.” Assuming *arguendo* that to be the case, *Thayer* does not disclose *a drive system operationally attached to the mounting system and configured to position the drawer relative to the opening in the data storage system*. *Thayer* appears to disclose a regulator apparatus 22, which may represent a type of drive mechanism, but the regulator apparatus 22 in *Thayer* is not attached to the mounting system. Thus, Applicants respectfully submit that *Thayer* does not disclose at least the above emphasized claim features, and respectfully requests that the rejection to independent claim 1 be withdrawn.

Because independent claim 1 is allowable over *Thayer*, dependent claims 2-6 are allowable as a matter of law for at least the reason that the dependent claims 2-6 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 7

Claim 7 recites (with emphasis added):

7. A method for providing automated access to a plurality of data media located in an extendable drawer in an opening in a data storage system, the method comprising the steps of:
receiving information related to a specific position relative to the opening in the data storage system to which the drawer is to be moved; and
automatically extending the drawer to the specific position relative to the opening in the data storage system if the drawer has to be opened to the specific position, otherwise automatically retracting the drawer to the specific position.

Applicants respectfully submit that *Thayer* does not disclose at least the emphasized claim features. Column 13, lines 53-58 of *Thayer* provides as follows (emphasis added):

For example, if the system operator programs the mail slot data cartridge exchange system 10 to allow access to only three (3) data cartridges 14, the drawer extension regulator apparatus 22 prevents the system operator from further extending the drawer 16 once three (3) data cartridges 14 have been exposed.

In other words, the regulator apparatus 22 is not *automatically extending* the drawer, but instead, the drawer is extended by an operator. Further, retraction is not to *a specific position relative to the opening*, nor is it *automatic*. Thus, Applicants respectfully submit that *Thayer* does not disclose at least the emphasized claim features, and respectfully request that the rejection to independent claim 7 be withdrawn.

Because independent claim 7 is allowable over *Thayer*, dependent claims 8-9 are allowable as a matter of law.

Independent Claim 10

Claim 10 recites (with emphasis added):

10. A method for providing automated access to a plurality of data media located in an extendable drawer in an opening in a data storage system, the method comprising the steps of:
receiving information associated with one of the plurality of data media located in the drawer;

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based on the information associated with one of the plurality of data media, determining the corresponding predefined position relative to the opening in the data storage system; and

automatically extending the drawer to the predefined position relative to the opening in the data storage system if the drawer has to be opened to the specific position, otherwise automatically retracting the drawer to the predefined position.

Applicants respectfully submit that *Thayer* does not disclose at least the emphasized claim features. As discussed above, the regulator apparatus 22 is not *automatically extending* the drawer, but instead, the drawer is extended by an operator. Further, retraction is not to *a predefined position relative to the opening*, nor is it automatic. Thus, Applicants respectfully submit that *Thayer* does not disclose at least the emphasized claim features, and respectfully request that the rejection to independent claim 10 be withdrawn.

Because independent claim 10 is allowable over *Thayer*, dependent claims 11-14 are allowable as a matter of law.

Due to the shortcomings of the *Thayer* reference described in the foregoing, Applicants respectfully assert that *Thayer* does not anticipate Applicants' claims. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

V. Claim Rejections - 35 U.S.C. § 103(a)

Claims 2-5, 9, 12, and 13 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Thayer* in view of *Inoue* ("Inoue," U.S. Pat. No. 5,940,354) and further in view of *Luffel et al.* ("Luffel," U.S. Pat. No. 5,596,556). Applicants respectfully traverse this rejection for at least the reason the *Thayer* reference is disqualified under 35 U.S.C. 103(c).

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U.S. patent number 6,643,226 (hereinafter the '226 patent) has an issue date of November 4, 2003 and a filing date of October 27, 1998. The present application, however, has a filing date of August 23, 2001. While '226 patent has a filing date before the filing date of the present application, the publication date (issue date) of the '226 patent is after the filing date of the present application. Further, the present U.S. Patent Application Serial No. 09/938,155 and the '226 patent were, at the time the invention of the present application was made, both owned by Hewlett-Packard Company, as averred in the accompanying declaration under 37 C.F.R. §1.132 by the attorney of record. Therefore, the '226 patent only qualifies as prior art under 35 U.S.C. §102(e) and cannot be used in an obviousness rejection under 35 U.S.C. §103(a) since common ownership of the present application and '226 patent has been established. For at least these reasons, Applicants respectfully request withdrawal of the rejection under §103(a).

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CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



David Rodack
Registration No. 47,034